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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/328,749	06/09/99	GEBHARD J	ADI-005

021323 QM32/0620
TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

EXAMINER	
STASHICK, A	
ART UNIT	**PAPER NUMBER**
3728	12

DATE MAILED: 06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/328,749	GEBHARD, JEFFREY E.	
	Examiner	Art Unit	
	Anthony D Stashick	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: _____ .

DETAILED ACTION

Continued Prosecution Application

1. The request filed on May 25, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/328,749 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 9-10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coplans 3,550,597 in view of Lain 5,179,791 or Toschi 5,720,117. Coplans '597 discloses substantially all the limitations of the claims including the following: a torsion system 15; forefoot portion 17; rear foot portion 16; intermediate portion 18; intermediate portion coupling forefoot and rear foot portion together (see Figures); intermediate portion made of material to allow for rotation of forefoot portion relative to rear foot portion about the longitudinal line of the system (see Figures 4, 6, 12 and 13); forefoot, rear foot, and intermediate portions form a single plate (see Figure 1); the single plate is substantially rigid in a horizontal plane (see column 3, lines 40-42), the width of the intermediate portion is less than that of the rear and forefoot portions (see Figures 11, 2, 4, 12, 13, and 15). Coplans '597 does not teach or show that the forefoot portion of the torsion system spans the entire forefoot area of the sole. Lain '791 and Toschi '117 both teach that the torsion system that is located in the forefoot portion of the shoe can extend outward to cover the entire forefoot area of the shoe (see

Figure 1 of Lain and Figure 5 of Toschi '117) so that the load and force upon the foot could be spread out over a greater area. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the forefoot area of the torsional system of Coplans '597 to encompass the whole forefoot area of the sole, as taught by Lain '791 or Toschi '117, to better distribute the forces and load upon the user's foot so that no one area has to support more weight or impact than any other area.

4. Claims 1, 5-11, 15-17, 19-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderie 4,922,631 in view of Lain 5,179,791 or Toschi 5,720,117. Anderie '631 discloses substantially all the limitations of the claims including the following: a torsion system (9 in figure 1, or 116, 118, 119 shown in Figure 8 or that shown in Figure 4); a forefoot portion (119 or that where 111 is located in Figure4); rear foot portion (118 or that where 112 is located in Figure 4); intermediate portion (116 of Figure 8 or 110, 114, 115 of Figure 4); intermediate portion coupling together forefoot and rear foot portions (see Figures) and made of a material that allows rotation of the forefoot portion relative to the rear foot portion about the longitudinal line of the torsion system (see Abstract or column 4, lines 29-50); intermediate portion includes a rib (see Figure 6, ribs are 114, 115, and 116 while base is 113); rib tuned torsionability (see column 5, lines 62-66); at least one aperture 120 in rear foot portion; rear foot, forefoot and intermediate portions form a single plate (see Figures); the plate is substantially rigid in a horizontal plane (see column 4, lines 39-51); plate is between 1 and 15 mm thick (see column 4, lines 10-15); the width of the intermediate portion is less than that of the rear foot and forefoot portions (see Figures); plate comprises nylon (see column 4, line 7); plate comprises composite material (see Column 4, lines 55-59) including glass; front and rear foot portions comprise different material properties than intermediate portion (see column 4, lines 3-15 and 55-63); aperture formed in intermediate portion (that area between 115 and 166 or 116 and 114 in figure 6); outsole 2. Anderie '631 does not teach or show that the forefoot portion of the torsion system spans the

entire forefoot area of the sole or that the rear foot portion spans the entire rear foot area of the sole. Lain '791 and Toschi '117 both teach that the torsion system that is located in the forefoot portion and rear foot portion of the shoe can extend outward to cover the entire forefoot and rear foot areas of the shoe (see Figure 1 of Lain and Figure 5 of Toschi '117) so that the load and force upon the foot could be spread out over a greater area. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the forefoot and rear foot area of the torsional system of Anderie '631 to encompass the whole forefoot and rear foot areas of the sole, as taught by Lain '791 or Toschi '117, to better distribute the forces and load upon the user's foot so that no one area has to support more weight or impact than any other area.

5. Claims 22-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 21 in paragraph 4 above in view of Nagano et al. 5,446,977. The references as applied to claim 21 in paragraph 4 above disclose all the limitations of the claims except for the footwear being a cycle shoe and having a cleat attachment. Nagano et al. teaches that it is desirable to have a torsion system placed within a cycle shoe, with a cleat attachment (8, 9a, 9), to keep the foot located properly on the pedal of a bicycle to allow for the largest driving force possible to be transferred from the user's leg to the pedal. Therefore, it would have been obvious to place the torsion system of the references as applied to claim 21 in paragraph 4 above into a bicycle shoe, such as that shown in Nagano et al. '977, to aid in keeping the foot properly located on the pedal to get the most work out of the energy expelled by the rider and to help in correcting the twisting of the user's leg due to the pedaling of the bicycle. Nagano et al. '977 also shows the shoe containing an upper as seen in Figures 8-9.

6. Claims 2-4 and 11-14, and 18 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claims 1 and 9 in paragraphs 3 and 4 above. The references as applied to claims 1 and 9 in paragraphs 3 and 4 above disclose all the limitations of the claims except for the

specific degree of rotation of the forefoot portion to the rear foot portion, the thickness of the intermediate portion or the intermediate portion being made of graphite. It appears that it would have been a mere matter of testing and optimization to find the degree of rotation of the forefoot portion with respect to the rear foot portion that would best aid the foot to rotate the desired amount to counter the rotation of the foot due to knee movement. It also appears that it would have been a mere matter of testing and optimization to find the thickness and material makeup (as the material make up of the intermediate also is a factor in determining the necessary thickness needed) of the intermediate portion that would allow the desired rotation and to customized the torsion system to different people's feet. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to find the proper angle of rotation of the forefoot portion to the rear foot portion and the thickness and material of the intermediate portion that would best compensate for the twisting motion performed by the knee on the foot.

Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such

papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 308-5648, email CustomerService3700@uspto.gov .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http:www.uspto.gov/

Anthony D Stashick
Examiner
Art Unit 3728

ADS
June 16, 2001